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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/475,391   | 12/30/1999  | CARLOS A. SILVA JR.  | 06975/048001        | 6275             |
| 26171  | 7590        | 02/09/2005           | EXAMINER            |                  |
| FISH & RICHARDSON P.C.<br>1425 K STREET, N.W.<br>11TH FLOOR<br>WASHINGTON, DC 20005-3500 |             |                      | BAUGH, APRIL L      |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 2141                |                  |

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                          |                               |                              |  |
|--------------------------|-------------------------------|------------------------------|--|
| <b>Interview Summary</b> | Application No.<br>09/475,391 | Applicant(s)<br>SILVA ET AL. |  |
|                          | Examiner<br>April L Baugh     | Art Unit<br>2141             |  |

All participants (applicant, applicant's representative, PTO personnel):

(1) April L Baugh.

(3) Scott Markow.

(2) Le Luu.

(4) \_\_\_\_\_.

Date of Interview: 03 February 2005.

Type: a) ☐ Telephonic b) ☐ Video Conference  
c) ☒ Personal [copy given to: 1) ☐ applicant 2) ☒ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.  
If Yes, brief description: \_\_\_\_\_.

Claim(s) discussed: 36, 47, and 68.

Identification of prior art discussed: US Patent 6,677,968 to Appleman, US 6,081,830 to Schindler, US 6,434,599 to Porter.

Agreement with respect to the claims f) ☒ was reached. g) ☐ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

  
Examiner's signature, if required

## Summary of Record of Interview Requirements

### Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

### Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

#### Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

#### 37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,  
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

### Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Applicant pointed out with respect to the independent claims 36, 47, and specifically 68 that the Appleman reference teaches the creation of a group name table where multiple buddy list are within this table. Applicant argues that the group name table is equivalent to the buddy list they are speaking of and that furthermore Appleman does not disclose the selection of a buddy list based off of a trigger event. Examiner asked that the applicant clarify in the arguments the definition of a buddy list by citing the definition from the specification. Applicant agreed and also agreed to incorporate dependent claims that further define the buddy list as claimed in their invention. Applicant pointed out with the new 103c rule that the combination of Appleman with the prior art to reject claims 36 and 47 was invalid due to the same assignee. Examiner agreed to remove the Appleman rejection from the 103 rejection of independent claims 36 and 47 and their dependents. Examiner also explained the reasoning and gave support for the combination of Schindler in Porter in showing that a user can view a show and a buddy list can appear that corresponds with the viewed tv show so that the user can IM with others who are viewing the same show. Applicant agreed and further explained that there was no reference to a the selection from multiple buddy list, and the examiner agreed stating further search would be required after the submission of the applicant's response to the non-final rejection.

# FISH & RICHARDSON P.C.

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Date February 2, 2005

To Examiner April Baugh  
Art Unit 2141  
Telephone: (571) 272-3877

Facsimile number 06975-04800001 / (571) 273-3877

From Scott B. Markow

Re Agenda for Examiner Interview  
Application: 09/475,391  
Attorney Ref.: 06975-048001

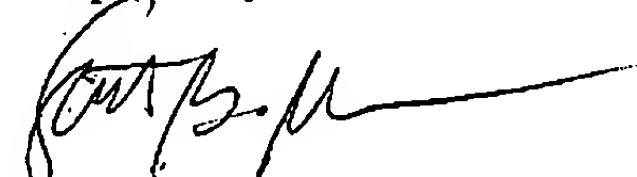
Number of pages  
including this page 2

Message UNOFFICIAL FACSIMILE COMMUNICATION

Dear Examiner Baugh:

Attached please find an agenda for the Examiner interview that is scheduled for Thursday, February 3, 2005 at 10:00 a.m. If you have any questions, please feel free to contact me at (202) 626-6389.

Respectfully submitted,



Scott B. Markow, Reg. No. 46,899

NOTE: This facsimile is intended for the addressee only and may contain privileged or confidential information. If you have received this facsimile in error, please immediately call us collect at 202 783-5070 to arrange for its return. Thank you.

**UNOFFICIAL COMMUNICATION**

**Agenda for Examiner Interview**

Application: 09/475,391  
Atty. Docket: 06975-048001

Date: February 3, 2005, 10:00 AM

Examiner: April Baugh  
Art Unit: 2141  
Phone: (571) 272-3877  
Fax: (571) 273-3877

Attorney: Scott B. Markow, Fish & Richardson P.C.  
Phone: (202) 783-5070  
Fax: (202) 783-2331

- I. Summarize claimed invention.
- II. Discuss rejection of independent claim 68, under 35 U.S.C. § 102(e), as being anticipated by Appelman (U.S. Pat. No. 6,677,968).
- III. Discuss rejections of independent claims 36 and 47, under 35 U.S.C. § 103(a), as being obvious over Schindler (U.S. Pat. No. 6,081,830) in view of Porter (U.S. Pat. No. 6,434,599) and further in view of Appelman (U.S. Pat. No. 6,677,968).

buddy list to the network user on an instant messaging user interface.” Each is serially addressed below.

Receiving User Definition of First and Second Buddy Lists

“The term “buddy list” refers to an aggregated collection of online identifiers for whom online presence is reflected. This term is defined in the Applicants’ specification as a list of “names of other server system users” and with reference to item 404 of Figure 4. Notably, Figure 4 makes clear the inclusion of buddy groups within and as a constituent parts of a buddy list, necessarily distinguishing buddy groups from buddy lists. This again is consistent with the ordinary meaning ascribed to the term buddy list.

Moreover, it is clear from the Applicants’ specification that the process of ascribing attributes to an online buddy or buddy group associates with a buddy list are processes that distinguish themselves from the process of receiving user definition of buddy lists. For example, the specification indicates that attributes may be ascribed to constituent buddies of a buddy list having buddy groups associated therewith. See page 3, lines 12-15.

In this context, Aravamudan fails to describe or suggest receiving user definition of a first buddy list and receiving user definition of a second buddy list, as claimed. Rather, Aravamudan describes the mere assignment of attributes (e.g., priority levels) to individual buddies within a buddy group. Aravamudan’s assignment of attributes to individual buddies in a buddy group may be similar to the assignment of attributes contemplated by the Applicants’ specification at page 3, lines 12-15, but it does not even relate to receiving user selection of multiple buddy lists, which is disclosed even within the Applicants’ specification as being distinct of the assignment of buddy attributes.

Moreover, the creation of buddy groups by Aravamudan also and similarly fails to meet receiving user definition of first and second buddy lists. Specifically, the buddy groups of Aravamudan are part of a buddy list and, therefore, fail to suggest creation (or receipt of user definition of) buddy lists to which they belong.

36. (Currently Amended) A method of providing a buddy list to a network user, the method comprising:

determining television programming selected for viewing by a network user at a networked device;

accessing two or more user-defined lists of other users for whom presence is monitored;

selecting an initial buddy list from among the two or more user-defined lists based upon the determined television programming, each of the two or more user-defined lists comprising members defined by the network user, the members comprising one or more other network users; and

displaying the selected initial buddy list to the network user on an instant messaging user interface, wherein the displayed buddy list comprises online presence information for the members of the selected initial buddy list.



68. (New) A method of providing a buddy list to a network user, the method comprising:

- receiving user definition of a first buddy list, the first buddy list comprising members defined by the network user, the members comprising one or more other network users;
- receiving user definition of a second buddy list, the second buddy list comprising members defined by the network user, the members comprising one or more other network users;
- receiving user input;
- triggering, based on the received user input, selection of a buddy list among the first buddy list and the second buddy list; and
- displaying the selected buddy list to the network user on an instant messaging user interface, wherein the displayed buddy list comprises online presence information for the members of the selected buddy list.